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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,303	11/21/2001	Paul A.E. Piunno	99-00	5364

23713 7590 08/26/2003

GREENLEE WINNER AND SULLIVAN P C
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SUITE 201
BOULDER, CO 80303

EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/993,303	PIUNNO ET AL.	
	Examiner	Art Unit	
	Sally A Sakelaris	1634	

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-77 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-24 and 72-74 are drawn to a substrate for hybridization of polynucleotides, and a kit for detecting the presence of a genetic target in a test sample comprising the substrate as classified for example in Class 435, subclasses 6, 69.1, 252.3, 287.2, and 320.1, Class 536, subclass 23.5, 24.31 and 24.33 and Class 536 subclass 23.1, 24.33, and 24.3

II. Claims 25-32 are drawn to a method of preparing a substrate for hybridization as classified for example in Class 435, subclass 287.2

III. Claims 33-47 are drawn to a method of hybridizing nucleic acids to a substrate, classified in for example, Class 435, subclass 91.1, 91.2, 287.2, Class 536 subclass 25.3.

IV. Claims 48-71, and 75-77 is drawn to a method of detecting the presence of a genetic target as classified in for example Class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

a. Inventions I and II, I and III, and I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of invention I can be used in a materially different processes such as for sequencing reagents and involving amplification and sequencing methods in order to achieve the objective of genotyping an individual for pedigree analysis and the substrate may be alternatively used for expression studies.

b. The methods of inventions II and III, II and IV, and III and IV are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially distinct methods, which require the use of different reagents, have different process steps and have distinct objectives. The method of invention II includes steps involving the connection to the substrate by a polyether moiety wherein the substrate comprises an optical fiber, an optical wave guide, etc. Invention III includes a method involving steps of contacting the substrate with a mixture of nucleic acids and subsequently wherein hybridization is detected by detection of fluorescence. Lastly the method of invention IV involves detecting the presence of a genetic target comprising a disease marker wherein hybridization is indicative of the presence of a disease state in the subject sample. In the instant case the different aforementioned inventions all have different functions and are not disclosed as capable of use together.

3. Because these invention are distinct for the reasons given above and have acquired a different status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-IV require different searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

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4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantai Dessau whose telephone number is (703)605-1237.

Sally Sakelaris



8/25/03



GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
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